

**REMARKS****I. General**

Claims 107-112 are pending, and have been rejected in the current Office Action. Applicant has amended claim 107. The issues in the current Office Action are:

- Claims 107 -112 are rejected under 35 U.S.C. §112, Second Paragraph;
- Claims 107-112 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter; and
- Claims 107-112 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,601,040 to Kolls (hereinafter “*Kolls*”).

**II. Amendments to the Claims**

Claim 107 is amended to clarify the claim language and to correct grammatical errors. Support for the amendments may be found in the language that was already in the claim. Accordingly, no new matter is added by these amendments.

**III. Delay by the Office in Examining the Present Application**

This application was filed December 23, 1997 and has been pending in the United States Patent and Trademark Office for over seven years. The present Office Action is the sixth Action issued for this application with no continuations having been filed. Two of the previous Office Actions were improperly made Final, and the finality in each case was later withdrawn. Three restrictions or election of species requirements have also been issued for this case. Additionally, there have been long periods of silence during which the Office apparently ignored the application, in particular there was an unexplained delay in examination from September 2001 to February 2003, a period of 17 months.

Effectively, the present Office Action is the ninth paper that addresses the claims, yet for the first time the Examiner has included rejections under §§ 101 and 112 for claim 107. Even if

valid, these rejections should have been made years ago in some previous Office Action. Claim 107 was introduced in June 2000 and slightly amended (adding nothing related to the present rejections) in June 2001. Four previous Office Actions failed to raise these issues. As discussed in more detail below, the rejections under §§ 101 and 112 are improper and should be withdrawn.

Furthermore, for the first time the Examiner has cited the *Kolls* reference against claim 107. This reference appears to claim priority to a provisional application that was filed seven months after the filing date of the current application. As discussed below, *Kolls* is clearly not prior art under §§ 102 or 103. Moreover, because it is the fifth in a series of continuation-in-part applications, there is no way to tell, without closely examining all of its parent applications, what material in *Kolls* can claim priority to any of the five potential priority dates listed as its Related Applications. The Examiner has made no such effort to identify the actual priority date for the material cited in the § 103 rejection.

In view of the foregoing, Applicant requests that the current rejections be withdrawn and that the present application be passed to issuance immediately.

#### **IV. Rejections Under 35 U.S.C. § 112**

The Examiner rejected claims 107-112 as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Applicant has deleted the alleged “intended use language” phrase “for processing financial data” from claim 107 to remove the language that the Examiner cited as confusing.

Applicant has deleted the phrase “said customers” in lines 2-3 of claim 107, which eliminates an antecedent basis issue raised by the Examiner.

Applicant has amended line 8 of claim 107 to clarify that a geographic area is identified “to a customer” rather than “for a customer.” Accordingly, this element does not raise the “intended use language” issue cited by the Examiner.

Finally, to the extent it is understandable, Applicant disagrees with the Examiner's assertion that "Applicant then attempts to positively [recite?] a plurality of customers." The cited word actually is "customer's" which is the possessive form not the plural form. Applicant is clearly identifying a wireless device belonging to the customer previously introduced in the claim.

Thus, Applicant submits that claim 107 is definite and clear, and requests the removal of the rejection under 35 U.S.C. § 112, second paragraph.

Claims 108-112 depend from claim 107 and appear to be rejected solely for that reason, since the Examiner fails to point out any instances of indefiniteness in these claims. "[T]he claim...if rejected as indefinite the examiner should point out wherein the indefiniteness resides..." M.P.E.P. § 707.07(d). As shown above claim 107 is definite, and Applicant respectfully submits that claims 108-112 are definite, at least in that they depend from 107 and no other instances of indefiniteness are pointed out. Therefore, Applicant respectfully request removal of the rejection under 35 U.S.C. § 112 for claims 108-112.

#### V. Rejections Under 35 U.S.C. § 101

The Examiner has rejected claims 107-112 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner states that the required elements of "claims 107-112 only recite an abstract idea." Further, the Examiner alleges that the recited steps "can be performed in the mind of the user or by the use of a pencil and paper." Applicant is unaware of an M.P.E.P. section or case law that sets forth such a test and requests that the Examiner provide a citation to the authority that establishes this test.

Claim 107 as amended cannot be performed in the mind of the user or by the use of pencil and paper. In fact, the receiving step requires the use of "a wireless device in communication with a wireless network." This element cannot be replaced by "pencil and paper" and cannot be accomplished in the user's mind. Therefore, the Examiner's rejection under § 101 should be withdrawn and the claims passed to issue.

Claims 108-112 state further applications using the customer's wireless device to process financial data, and depend directly from claim 107, which as amended is asserted to be allowable, thus Applicant respectfully submits that claim 108-112 are allowable.

**VI. Rejections Under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 107-112 under 35 U.S.C. § 103(a) as being unpatentable over *Kolls*. Applicant traverses this rejection and asserts the claims are allowable at least for the reasons stated below.

*Kolls* does not constitute prior art. The earliest effective filing date to which *Kolls* might potentially claim priority is July 20, 1998, which is seven months after the present application was filed (December 23, 1997). Therefore, *Kolls* is absolutely not prior art under 35 U.S.C. §§ 102 or 103. Applicant respectfully submits that Claims 107-112 are allowable under 35 U.S.C. § 103(a) in view of the *Kolls* reference and should be passed to issue.

**VII. Conclusion**

In view of the above amendments and remarks, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 51410/P003US/09705003 from which the undersigned is authorized to draw.

Dated: February 4, 2005

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